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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1967

DOMENICO MASTINI,
Petitioner

vs.

AMERICAN TELEPHONE AND TELEGRAPH CO. and WESTERN ELECTRIC COMPANY
Respondents

DOMENICO MASTINI,
Petitioner

vs.

NEW YORK TELEPHONE CO.
Respondent

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS, SECOND CIRCUIT

BRIEF FOR PETITIONER

OPINION BELOW.

The decision of the Southern District Court of New York is included in the Record Vol. I APP. I and the decision of the same Court for a Motion on Rule 60(b) is included in the Record, Vol. III # 261a. The judgment of the Court of Appeals, sought to be reviewed is dated November 29, 1966, and entered on same date. The extention of time to file the present Petition was given on January 24, 1967 until April 28, 1967

Dec. reported 236 F. Supp. 310-369 F. 2d. 378

JURISDICTION

The jurisdiction of this Court rests on 28 U.S.C. Section 1254

QUESTIONS PRESENTED

1. Whether the proper construction of the word "cause" should be made also in the light of the scientific meaning of the basic electronic terms "radiosignal" and "demodulation" and whether said constructions were or were not fact-findings not permitted in a summary judgment.

2. Whether could be declared the existence of a File Wrapper estoppel because the inventor was "forced" to include in claims the "substation" and its "automatic disconnection", when said features were already in original specification,claims and drawings and whether said declaration of "estoppel" was or was not a technical fact-finding.

3. Whether a File Wrapper Estoppel could be declared for the only fact of the cancellation of the broad original claims when the claims subsequently allowed had retained all the substance of the claims rejected and whether the comparison readable in the summary judgment between electronic claims allowed and rejected, was or was not a fact-finding.

4. Whether, in interpreting patent specification and claims the direct,complete examination of the prior art cited could be omitted and whether a summary judgment could be granted and affirmed

when in the record before the trial court was totally lacking in the record, the prior art to be examined.

5. Whether the inventor had the duty in Patent Office, to indicate in patent, besides the best mode, also other possible modes of actuaction of his invention.

6. Whether in construing a patent in a summary judgment, references to the correspondence between inventor and Patent Office could be used especially when they were not pertinent to the claims in issue.

7. Whether questions of propriety of the "place" where an infringing device is located are material in patent case and whether the correct interpretation of the functions made by said device in said place was or was not a fact-finding.

8. Whether a Court of Appeals in deciding upon an appeal against a summary judgment could make a new fact-finding also non-concurrent.

9. Whether the grant of a certiorari is opportune in a patent case where there are suits, about the same patent, filed and entertained in other Circuits involving infringements of the same patent.

10. Whether the summary judgment affirmed by the Court of Appeals below had lost its finality when the plaintiff, before hearing and decision in said Court, had filed and entertained in District Courts of Delaware and Maryland two independent actions under Rule 60 (b) in order to obtain the setting aside of said summary judgment, and

Immigration and Naturalization Service
20 West Broadway
New York, N. Y. 10007

SEP 14 1966

File No.: A14 400 806 (NYC)

In re: Petition of DOMENICO MASTINI in his own behalf.

APPLICATION FOR CLASSIFICATION OF BENEFICIARY UNDER SECTION 203(a)(3) OF THE IMMIGRATION AND NATIONALITY ACT, AS AMENDED.

In Behalf of Petitioner: Self-represented.

This petition was submitted by Domenico Mastini, a 69-year-old native and citizen of Italy, to have himself accorded third preference classification under Section 203(a)(3) of the Immigration and Nationality Act, as amended. Mr. Mastini seeks classification as an alien who is a member of the professions, or who because of his exceptional ability in the sciences or arts will substantially benefit prospectively the national economy, cultural interest or welfare of the United States. He is an inventor and resides with his wife, Annita Travalgini Mastini, in New York City. Mr. Mastini desires to continue his work as a self-employed inventor in the United States.

Evidence has been submitted that Mr. Mastini studied at various technical universities in Naples and Rome for nine years and received a "Diploma Fisico-Matematica" from the Instituto Tecnico di Veterbo, Rome, Italy, in 1929. While a student, he studied physics with Enrico Fermi, a distinguished physicist.

Mr. Mastini has been a self-employed inventor for more than 30 years. He won first prize at the Leonardo da Vinci exposition, Milan, Italy in May 1939, for his work in the field of radio-telephone communications. Mr. Mastini was awarded "The Cup of The King and Emperor", a nationally recognized prize, by the Italian Government, in December 1939, for his development of the automatic radio-telephone. He subsequently served as president and manager of the firm "Radio Telefoni Automatici Mastini" in Milan, Italy, which was engaged in the manufacture of radio-telephone apparatus. He is presently active in the field of hydraulic power generation. Mr. Mastini has been issued several patents by the United States Patent Office during the past 30 years for his work in the fields of electronics and communications.

On April 8, 1966, inquiry was had with the Department of Labor, Washington, D.C., with respect to the certification of the Secretary of Labor, pursuant to Section 212(a)(14) of the Immigration and Nationality Act, as amended, to solicit advise as to whether the occupation was encompassed within the blanket certification of Schedule A of 29 C.F.R. 60.

The Department of Labor replied that Mr. Mastini appeared to be qualified for third preference classification and that since he intends to remain self-employed he is not considered by that Department to require the specific certification of the Secretary of Labor.

In view of the foregoing, it is concluded that Mr. Mastini possesses exceptional ability in the sciences and that his activities would substantially benefit prospectively the national economy and welfare of the United States. The petition will, therefore, be granted.

ORDER: It is ordered that the petition by Domenico Mastini to have himself accorded third preference classification be and the same is hereby granted.

P. A. Esperdy

P. A. ESPERDY
District Director
New York District

whether therefore, the Court of Appeals below had or had not jurisdiction to examine and decide the instant case.

STATUTES INVOLVED

35 U.S.C., Section 271-272

STATEMENT OF FACTS

The instant action refers to the "Mobile Telephone" now widely used in this and in all civilized countries, an invention patented by the plaintiff, an Italian national by patent no. 2,129.1332 on September 6,1938 with priority April 4, 1935 (App.15-18).

Said patent was vested with Alien Property Custodian on 1942 during the war and remained vested, without any justification and of course without any compensation,until November 27,1956, one year after its expiration and eight years after Lovett-Lombardo Treaty on 1947,authorizing said return. During this period there was considerable infringement of plaintiff's patent.

The return was finally made by Return Order No. 2578 indicated also in complaint and in said order it was written:

> "...is thereby returned to Domenico Mastini: All rights,title and interests in and to Patent No.2.129.332--including all accrued royalties and all damages recoverable at law or in equity,for the past infringement."

without any limitation about the duration of said "past infringement". By said ruling and also by the following authority:

> "Herber v. U.S. 322 F.Supp.451,This provision,the last paragraph of the 35 U.S.C. section 286, if applied in this case it would have the effect of tolling the statute of limitation for approximate the period from September 3, 1947 to January 22,1953, and allow plaintiff to add to their six year period of recovery some five and one-half years."

the period of infringing activity is therefore much longer than the 14 years of the "vested" period and also much longer than the "about one month's infringing activity" asserted by the defendants on page 2 of their first brief.

About the period of damages the defendants,before the lower courts in order to "minimize" the economic importance of these suits deliberately ignored the above-mentioned ruling and authority.

The defendants had asserted that the case was economically negligible and that also a summary judgment could be granted.

In any event,whatever can be the period of infringement,the amount of the damges will always be relevant because of the great number and high cost of the radio telephone systems made and used by the defendants during the life of the patent.

It is necessary to say that in the present suit there is also involved a question

DEPARTMENT OF COMMERCE
Daniel C. Roper, Secretary

Bureau of Foreign and Domestic Commerce
Alexander V. Dye, Director

ITALY
2-WAY PHONE

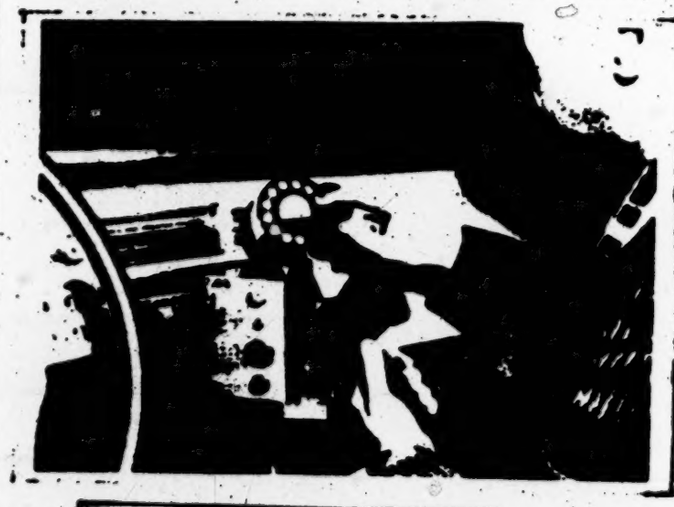
RADIO MARKETS SUPPLEMENT -- ITALY

MASTINI AUTOMATIC RADIOTELEPHONE SYSTEM

Price 25 cents - Issued by the ELECTRICAL DIVISION, Andrew W. Cruse, Chief - April 21, 1936

The Mastini automatic radio-telephone is a brilliant example of the most recent progress in telephonic communication: that is, the liberation from the drawbacks of a fixed installation. The portable automatic apparatus, whether in the automobile or in the pocket, will play a large part in the life of the up-to-date man, perhaps equal in importance to the introduction of the ordinary fixed telephone in the past.

App. 174



A two-way dialing system installed in an automobile.

This year we shall be introducing a much improved mobile telephone service. Calls to or from vehicles may be dialed directly; the equipment automatically selects one of several radio channels; and the inconvenience of pushing a button to talk, and releasing to listen, is eliminated.

AMERICAN TELEPHONE AND TELEGRAPH COMPANY

MOBILE RADIO CHANGES THE PACE OF THE NATION

Merle E. Fl[illegible]el
Federal Communications Commission
Washington, D. C.

of international character since the Lovett-Lombardo Treaty on 1947 foresaw the duty of the Italian Government to pay an indemnity to the inventor for the infringing use of the Mastini Patent until December 31,1945.

The plaintiff, in order to get such an indemnity must submit to said government a U.S. Court's decision proving said use.

The subject patent had disclosed a new telephone radio-wire system able to expand directly and almost indefinitely the field of action of a single subscribers telephone lines coming out from the usual central exchange accomplishing thus "the liberation of the telephone apparatus from the drawbacks of a fixed installation."

This clear syntetical definition of the Mastini invention has been given by the official publication of the U.S.Department of Commerce of 1936 (Record Book I,App.24-26) entitled "Mastini Automatic Radio-Telephone System" which on page 3 stated:

> "The Mastini automatic radio telephone is a brilliant example of the most recent progress in telephonic communication that is the liberation from the drawback of a fixed installation.,
>
> The portable automatic apparatus,whether in the automobile or in the pocket will play a large part in the life of the up-to-date man perhaps equal in importance to the introduction of the ordinary fixed telephone in the past".
> Said profecy becoming always more true.

On 1955 - date of expiration of the Mastini patent, Mr. Kerel E. Floegel of the Federal Communication Commission (F.C.C.) has written an article which is entitled "Mobile Radio changes the pace of the Nation" is highly expressive in itself about the truth of said profecy.

The defendants maintained that the Mastini patent was a valid one and that they did not infringe it since it was a fully automatic operation while theirs was a semi-automatic operation not converted to fully automatic until after the Mastini patent expired.

Moreover in order to deny Mastini the benefits of the theory of equivalence they maintained that he was estopped.

Even though their estoppel theory was based upon the prior art cited 30 years ago in Patent Office, the defendants failed to introduce this prior art before the trial Court in order to avoid its examination by the trier of facts,which,had it been examined, would have precluded a summary judgment because of its complexity.

The trial court,in contrast with the U.S.Supreme Court, and Second Circuit's authorities, has interpreted the invention and its patent claims by examining only the File history and specification without examining the prior art cited and thus without information to determine the "true" point of the invention and the real contribution of this invention to the prior art.

The lower courts believed that the Mastini invention was for an insignificant

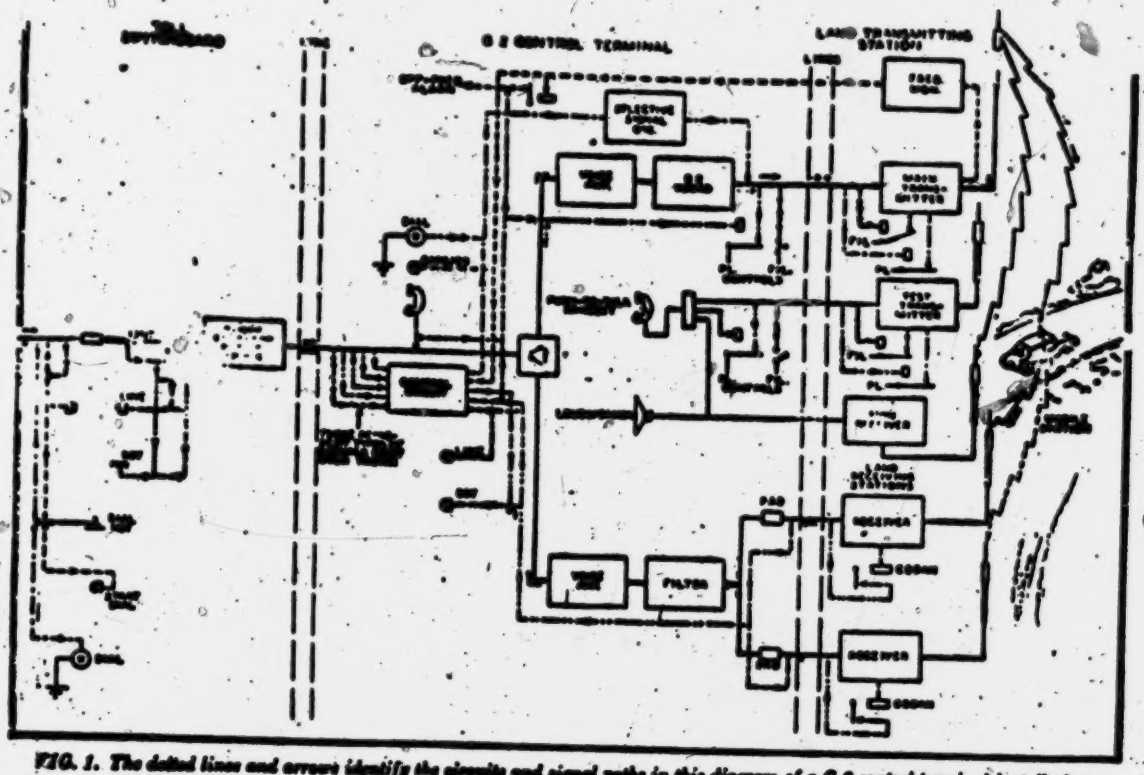


FIG. 1. The dotted lines and arrows identify the circuits and signal paths in this diagram of a G-2 control terminal installation

LAND-LINE MOBILE SERVICE

WESTERN ELECTRIC G-2 CONTROL EQUIPMENT INTEGRATES TELEPHONE SERVICE BETWEEN MOBILE UNITS AND LAND-LINE SUBSCRIBERS—*By* B. P. COTTRELL*

THE rapid expansion of mobile telephone service is reaching more and more into the daily lives and interests of the American public. This is due, in a large measure, to progress achieved in making service available between mobile installations and the established telephone system, through the exchange switchboards.

The use of mobile radiotelephone installations is no longer a novelty. However, the methods and equipment used to extend normal, efficient telephone service to private cars and trucks is still something of a mystery, even to many communications engineers.

Mobile telephone service in urban areas and along highways between principal cities has become more than a two-way system since the introduction of selective dial signalling and direct interconnection with land-line telephone subscribers.

* Mobile Radio Sales Engineer, Radio Division, Western Electric Company, 120 Broadway, New York 5, N. Y.

A typical setup is illustrated in Fig. 1. It comprises:

1. Main transmitter, installed at an advantageous point, and operated by remote control
2. A test transmitter, operated on the same frequency as the mobile transmitters, so that the technical attendant, listening on a monitor receiver tuned to the main transmitter frequency, can check the operation of the system. The test transmitter and monitor receiver are equivalent to a mobile station
3. One or more fixed receivers, located where signals from the cars can be picked up most efficiently, and connected to the telephone switchboard by land lines
4. The telephone switchboard
5. The G-2 control unit which integrates the various operating units of mobile and wire telephone service into a dependable and efficient system

G-2 Control Equipment

Fig. 1 shows the circuit elements of the Western Electric G-2 control between the two pairs of dotted lines. Figs. 2 and 3 show an installation of four G-2's, one of which is in cabinet, while the other three are rack-mounted. In this particular installation, the unit at the left handles the Philadelphia link in the New York-Washington highway system. The adjacent rack-mounted control is for the Philadelphia urban channel, designated by the FCC as No. 11, while the next control is for the Philadelphia urban channel No. 9. At the extreme right is the control for New York-Washington rail phone.

The panels on each control, from the bottom up, carry the following circuits:

VOICE-FREQUENCY MONITOR AMPLIFIER, used if a receiver is located at some distance, to raise the volume

RECEIVER CONTROLS, to match the output of the receivers to the G-2 control

VODAS, which regulates the speech level from land-line telephones

JACK FIELD, to facilitate the control and testing of the various circuits

APP. 151

improvement (the automatization of the operator's manual operation of disconnection of the telephone substation) without noting that,instead,said invention was,in reality for a new "radio-wire" system,as represented by the defendants themselves in their "1955 Mobile Telephone" diagram (Record,Vol I APP. 104a) substantially different in "principle" number of components and operations from the prior art cited and also from their early "1929 Radiotelephone"Diagram (Record,Vol.I APP.104).

The Mastini idea was for the extension, via radio, of the subscriber's lines toward a specific subscriber car or like by an "interconnection" (doc. att.) with every "means" available (automatic-semiautomatic or manual) and not with the sole automatic method as claimed by the defendants and as the lower Courts have stated. In the Mastini invention the sole thing that was necessarily automatic was the added "radio complex", the method of disconnection could also be manual.

The Mastini invention consisted of the "coordination" of a fixed automatic radio apparatus with the "telephone substation" of any usual subscriber as well as a special subscriber: in the home or in any other private or public place, a subscriber station could be found.

The Mastini invention was not in the "means" (which were already established) and not in the "place". It was a new and different comibination of established components. It was new and different with respect to the cited prior art since it had a "subscriber substation" that was not in the cited prior art.

Thus, if as clearly found by the lower

improvement (the automatization of the operator's manual operation of disconnection of the telephone substation) without noting that,instead,said invention was,in reality for a new "radio-wire" system,as represented by the defendants themselves in their "1955 Mobile Telephone" diagram (Record,Vol I APP. 104a) substantially different in "principle" number of components and operations from the prior art cited and also from their early "1929 Radiotelephone"Diagram (Record,Vol.I APP.104).

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The Mastini invention consisted of the "coordination" of a fixed automatic radio apparatus with the "telephone substation" of any usual subscriber as well as a special subscriber: in the home or in any other private or public place, a subscriber station could be found.

The Mastini invention was not in the "means" (which were already established) and not in the "place". It was a new and different comibination of established components. It was new and different with respect to the cited prior art since it had a "subscriber substation" that was not in the cited prior art.

Thus, if as clearly found by the lower

Courts the prior art had not "substation" since the Mastini patent was issued because of this addition,then obviously, in the prior art, there was no disconnection operation and therefore there could not be a manual operation for disconnection.

In the Mastini invention also, as disclosed in original application,there was a disconnection operation both manual or automatic.

The defendants and both the lower Courts state that Mastini was "forced" to adopt an automatic disconnection system in order to qualify his patent and distinguish it from the prior art. This could be true if there was, in the prior art cited, a prior manual operation in a system as disclosed by Mastini. But, if the prior art had no "substation" then obviously it had no manual or any kind of disconnection,and then Mastini could not be forced to change his system from one which was not in existence in a non-existent system.

SUMMARY OF ARGUMENTS

Since the summary judgment of the trial court is based upon the generalized and vague knowledge that "radiosignals" are used for remote control, the court below having not noted that,instead, in order to indicate "tele' controls" the proper scientific terms are, instead, "carrier wave" or "radiant energy", erroneously affirmed the summary judgment making error in fact,plain for any skilled in the art.

The Court of Appeals below, has made error in fact when it recognized the existance of an estoppel because the plaintiff was forced to include "substantion" and "automatic disconnection" when,instead,said features were already in original patent application.

Since the sole cancellation of broad original claims not necessarily brings to an estoppel, the Court below made a decision in conflict with applicable authorities. Authorities of the Supreme Court state that in construing a patent the prior art must be examined and that a summary judgment can be rendered provided that the prior art be understandable by the sole judicial notice. The Court of Appeals below,although the prior art was totally lacking before the Court and therefore could not be understood, has erroneously affirmed the summary judgment in conflict with applicable authorities.

The plaintiff having illustrated in patent, an automatic method as the best mode, is protected also against any other possible mode falling within the scope of the claims of his patent.

The Court of Appeals requiring a condition not necessary made a decision in conflict with authorities of the Supreme Court. The Court of Appeals in justifying its decision by correspondence readable in File History has violated authorities of the Supreme Court and of other Circuit Courts because the quotations cited in the decision were pertinent solely to the set of claims submitted some months after the submission of the claims which were allowed.

In the record before the Court of Appeals below, was existent a clear defendants document proving that the Mobile Service Position (the "place" where is used the fixed part of the Mobile Telephon) is outside and not inside the "true" central plant by the usual two subscribers wire lines having, as usual, a subscriber telephone substation with dial, has not well observed the "existence of two different buildings": one for the central plant and the other for the Mobile Service Position.

In any way, questions of title of property of the "place" where the patented device is located, are not proper in a patent infringement case where technical questions should be examined only and not questions of real estate.

The Court of Appeals below, stating that the inventor was forced in Patent Office to include the substation, in his patent claims, made a non-concurrent fact-finding with the summary judgment of the trial court about a basic point of the case.

Then, since decision based upon fact-findings are not permitted in a trial court in a summary judgment, for the same and other reasons, a Court of Appeals erred in making in the present case, said fact finding in conflict of applicable authorities.

The resolution of said non-concurrent finding is for this Supreme Court with a certiorari and the point is very important that if it be resolved in the sense that the Court of Appeals below was wrong the entire case should be resolved in favor of the Petitioner.

The patent in this suit is involved in several other suits in other Circuits. According to authorities of this Court, in order to avoid eventual conflict in future decisions, a certiorari stating what is the "true" interpretation of debated electronic terms, will be opportune in the interests of justice and convenience of the parties.

Before the hearing and the decision of the Court of Appeals,the plaintiff filed and entertained in the District Court of Delaware and Maryland two independent actions under Rule 60 (b) depriving of finality the appellate decision of the trial court below.

These facts were made available to the Court of Appeals, but it disregarded the lack of its jurisdiction and decided the case affirming the summary judgment, thus making a decision void on jurisdictional grounds.

ARGUMENT

I

IN THE PATENT IN SUIT THE TERM "CAUSE" WAS NOT AMBIGUOUS BECAUSE ITS MEANING DERIVED DIRECTLY FROM THE PROPER MEANING OF THE WORDS "RADIOSIGNAL", AND "RADIOSIGNAL", IN TURN, WAS NOT AMBIGUOUS BECAUSE IT HAD BEEN CLEARLY DIFFERENTIATED FROM THE TERM, "CARRIER WAVE" (ENERGY): HENCE, "RADIOSIGNAL" COULD NOT BE INTENDED AS WERE ITSELF ACCOMPLISHING THE AUTOMATIC DISCONNECTION.

The Court of Appeals stated in its decision that the controversy turns on the proper construction of the words "cause" and local substation". In reality the controversy turns, above all, on the proper construction of "radiosignal" with respect to "carrier wave" (energy).

This is proved by the fact that the trial court stated: (Record Vol.I APP.6)

> "The language of claims 1 and 3 reads that the "radiosignal" itself "cause(s)" the disconnection and connection"

substantially stating that "radiosignal" acted as "energy" (carrier wave). Therefore it is evident that the controversy turns upon the true technical meaning of "radiosignal" with

respect to the true technical meaning of"carrier wave", when interpreted in the light of language as "it is used in the art and not in vague or generalized ways". (Aerosol Research Co. v. Scovil Mfg. Co. DC.Ill.-137 U.S.P.Q. 701).

Only if "radiosignal" had, in the art, really the same meaning of "carrier wave", could the summary judgment be correct.

But also admitting that the controversy turns on the proper construction of "cause" it is undeniable that it is necessary to search for the proper meaning also of the terms "radiosignal" and "after demodulation".

About the term "radiosignal" the verb"to cause", used in patent claims, is defined in Webster Dictionary published on 1936 by the World Syndicate Publishing Co., page 266,as follows:

"1. To produce, to bring into existence
2. To effect by agency,power or influence "

Funk & Wagnalls Standard Dictionary,1963 Library of Congress Catalog N.63-17360,page 356 defines the verb "to cause" as follows:

"1. ....
2. To effect by command,authority or force (the President caused the ambassador to protest).

The two Dictionaries, and particularly the 1936

Dictionary, are referred to in order particularly to clarify the fact that,in wording his claims, Mastini intended to include in their scope a human agency caused to perform certain acts by the recited "means".

Moreover, the scientific meaning of"radiosignal" is not that of "energy".

This is proved by the following arguments:

1. In the patent the claims were differentiated in two groups:

a) Claims 1,2,3, with radiosignal
b) Claims 4-11 with "carrier wave" or "energy"

In such a condition the word "cause" or "causing" takes a "manual" meaning in claims having "radiosignal", and takes the automatic meaning in the claims where "carrier wave" or "energy" are included. By their different meaning said words are not interchangeable.

2. On Page APP.164,Record.II.,Vol.,or on page 309a Record III.,Vol. line 5, it is visible and readable the cancellation of the word "signal" substituted by "carrier wave". If the words should have the same meaning,the Patent Office would not have permitted the change of a word with another word having the same meaning.

3. Moreover on page APP.168 or on page 308a Record III.,Vol. the American definition of Electrical Terms, for the word "carrier wave" gives this definition:

"A carrier wave is wave suitable for being modulated"

4. What is more, on Mastini patent, first page,second col. lines 28-32,APP.159 Record III.,Vol, reads:

> "Upon the lifting off of the microphone,however,both circuits are closed by the hook 27 and the trasmitter begins to send a carrier wave and so long as there is no modulation...."

Therefore, since also in patent Fig. 2 is used the "carrier wave" for command of the relays 41 and 47 "so long as there is not modulation" then also the patent proves that it is the "carrier wave" and not the "radiosignal" that accomplishes the automatic disconnection.

These interpreting ways bring all to the same conclusion: in the proper language, "as used in the art and not in a vague or generalized way" only the "carrier wave" and not the "radiosignal" accomplishes the remote control for the automatic disconnection; namely claims 4-11, and not claims 1,2,3., are automatic claims.

Consequently, the decision of the Court of Appeals affirming that "radiosignal" itself "cause"automatically the disconnection, is also erroneous in fact.

To note that the first basic inventive point of the invention was the "radio command of the relay 41" alerting the operator lighting a lamp: before the Mastini invention (1934-1935) said alerting operation was made via radio by voice from the vessel to operator.

This was the first sole indispensible op-

eration, automatic: This is not denied by the lower courts; as the unfair defendants have made the Courts believe, these courts have understood the Mastini invention as limited to the sole automatic disconnection. If a regular trial with expert testimony was permitted, said question of principle of the invention would be made very clear to the Court.

ABOUT THE WORDS "AFTER DEMODULATION"

Furthermore, in order to give the proper construction to the word "cause" in claims 3, we need to find also the scientific meaning of the electronic term "demodulation", a term that the trial Court could not understand by its judicial notice only.

Prof. Zambuto in his affidavit (Record Vol.III APP. 210) after having reported the scientific definition of "demodulation" readable in the textbook used by the Brooklyn Polytechnic Institute, stated that the system described in claim 3, by virtue of the wording "after demodulation", should be interpreted as a system in which an audio (e.g. voice) signal obtained by "demodulation", can cause an operator to manually perform the connection and disconnection indicated by same claim".

Moreover the plaintiff in order to facilitate the lower court in understanding said scientific term had included on page APP.211 Record III Vol., copy of page 19 of the radiotechnical publication "Boating" of Skillfact Library, where it states:

> "converting radiowave back into voice signals at the receiver

> loudspeaker is called "demodulation".

The plaintiff had, of course, pointed out to the lower courts said wording but they have given no consideration to it, obviously because it could be made clear to the Court only by expert witnesses on cross-examination.

The lower courts have made thus a decision in conflict with their own authorities:

> "Essential element in a claim cannot be ignored in construction of patent"
> (2 Cir. 1931) Heil v. Walter 47 F. 2d 551.

> "In patent law, perhaps more that in any other area of law, each word employed is of greater weight and significance."
> (C.C.A. 2 Cir) Helen Curtiss v. Layden 233 F.2d 148

In the case of Harries et al v Air King Product, 87 F. Supp. 572 on page 582, states:

> "The electronic art is a particularly technique and scientific field and hence this specification and the claims must meet the understanding not of a layman, but of "any person skilled in the art or science to which it pertains."

In United Carbon Co. v. Binney & Smith Co. 317 U.S. 228 at page 233, 63 S.Ct. 165, at page 168, 87 L.Ed. Mr. Justice Jackson, speaking for

the Court said:

> "Here, as in many other cases, it is difficult for persons not skilled in the art to measure the inclusion or to appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself."

II

THE COURT BELOW WAS IN ERROR IN CLAIMING THAT THE INVENTOR WAS FORCED TO ADOPT SOME FEATURES BECAUSE SAID FEATURES WERE ALREADY IN THE ORIGINAL PATENT, THUS THERE WAS NO ESTOPPEL.

The Court of Appeals in its decision stated two types of "estoppel"

a) "Chief Judge Ryan held that appellant was estopped to assert that the Mastini patent included any other than an automatic disconnection."

b) "as Mastini was forced to add this "substation" to his claims to avoid rejection on the prior art, he is estopped to now include what he was forced to abandon to obtain his patent."

332

Sept. 6.

Print of drawing as originally filed.

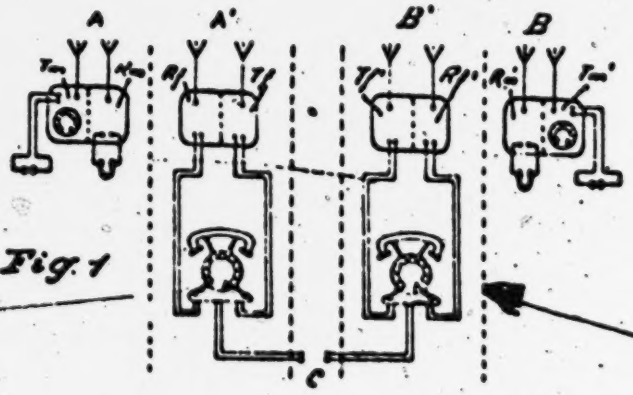


Fig. 1

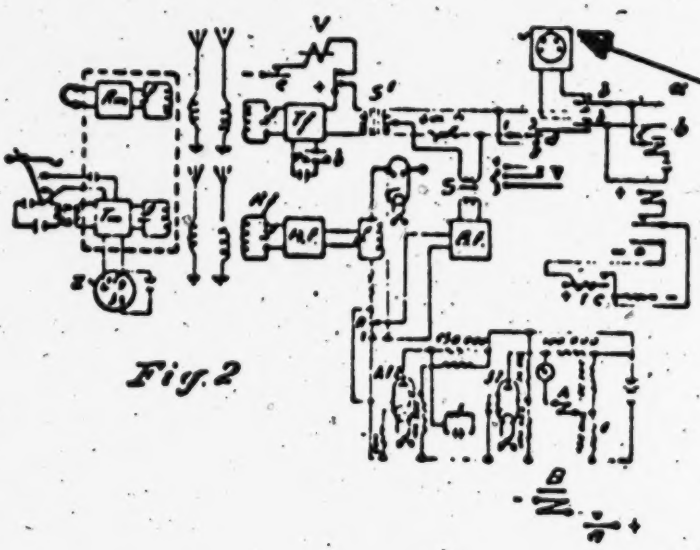


Fig. 2

But instead, as a matter of fact, Mastini was not forced to said features for the simple but fundamental reason that the "substation" and its "automatic disconnection" were already in Mastini's original application.

A. MASTINI WAS NOT FORCED TO INCLUDE THE TELEPHONE SUBSTATION.

The proof that the "substation" was already in the Mastini original application is given by the File History itself.

In fact, on page 88a (Record, Vol.II) it is stated:

"1. A telephone system comprising...whereof a number of subscriber stations are provided, besides the usual telephone apparatus...etc."

on same page 88a it states:

"2. A telephone system according claim 1, comprising a usual telephonic network whereof a number of subscriber stations....."

The "usual telephone apparatus" and the "subscriber stations" in original Fig. 2 are the very same "telephone substation" that, according to the decision of the Court below, Mastini was "forced" to include.

On pages 278a, 279a and 280a Record.Vol. III are listed other important arguments ex-

plaining how the defendants had mislead the lower courts about said nonexistent "forced" inclusion of the substation in patent claims 1,2,3.

B. MASTINI WAS NOT EVEN FORCED TO THE AUTOMATIC DISCONNECTION

Also about this question it is here attached for convenience of the Court,copies of original pages 88a and 91a of R. II.

The simple comparison visible in said copies between original Fig. 2 (91a Record.Vol.II) and patent Fig. 2 (APP.I59 Record Vol.I) shows at first glance, that the automatic disconnection of the substantion from the telephone lines in Fig. 2 of the patent, is identical to the automatic disconnection of the substation in original Fig. 2.

Moreover, on page 88a (Record Vol.II) it reads:

> "A telephone system according to claims comprising a usual telephone network whereof a number of subscriber stations are provided of wireless receiving and sending sets, and a number of distant wireless sending and receiving stations, the said distant stations being suitably equipped for producing in the telephone apparatus of the network provided with wireless sets, the taking off...."

Correspondently, the description of said automatic operation is readable on page 85a,Vol.II. This description concludes: THIS OPERATION CORRESPONDS TO THE TAKING OFF OF THE MICROPHONE.

91a

File Wrapper Mastini Patent 2,129,332
Exhibit A to Affidavit of George C. Lord

15342

332
Sept. 6.

Print of drawing as originally filed

Fig 1

switches -b- and-b-identical
switches 49-51 in patent

Fig 2

Relays A identical
relays 75 in patent

Relays B identical
relays 47 in patent

1 11 250-6.

Sept. 6, 1938. D. MASTINI 2,129,332

TELEPHONE SYSTEM

DOC. 8

Fig. 1.

TELEPHONE CENTRAL

Fig. 2.

switches

relays

Inventor
Domenico Mastini

By E. F. Wenderoth
Attorney

A

In original Fig.2 (left) same automatic means as in patent fig.2. If "automatic" disconnection in original application, Mastini could not be forced to include a thing already included.

Now when the descri
is read looking at
seen that the teler
tomatically disconn
lines -a- and -b-.
disconnection, also
the inventor, cannot
ual taking-off of a
lower courts believ

Since in the c
was the automatic d
could not be "force
tion that he had al
he was not forced,
ped" and if he is n
1,2,3 can be read a

a) because th
claim 1 and Fi
automatic mean
system,

b) by the th

Also, the cancelled
matic disconnection
page 97a Record. Vo

On page 282a B
detail the existence
nection also in the

The foregoing h
ginal documents in
the automatic discon
original application
ror in fact made by

Now when the description for said "taking off" is read looking at the Fig. 2, then it can be seen that the telephone apparatus is truly automatically disconnected from the telephone lines -a- and -b-. Obviously, said automatic disconnection, also if called "taking off" by the inventor, cannot be confused with the manual taking-off of any usual handset, as the lower courts believed.

Since in the original application there was the automatic disconnection, then Mastini could not be "forced" to include a disconnection that he had already included; again, if he was not forced, he, now, is not even "estopped" and if he is not estopped, then his claims 1,2,3 can be read as manual claims:

a) because the original application by claim 1 and Fig. 1 both lacking of any automatic means, had disclosed a manual system,

b) by the theory of equivalents.

Also, the cancelled claims 8-11 had the automatic disconnection as proved by Fig. 2 on page 97a Record. Vol. II.

On page 282a Book III it is explained in detail the existence of the automatic disconnection also in the cancelled claims 8-11.

The foregoing has thus proved, by the original documents in File History, that really the automatic disconnection was existent in the original application proving thus the basic error in fact made by both the lower Courts.

C. ALSO THE DECISION OF THE COURT OF APPEALS BRINGS,ON ITS FACE, TO THE SAME CONCLUSION OF "NON-ESTOPPEL"

The decision of the Court below states that Mastini, to avoid the rejection of his claims had been forced to include, in said claims, the substation.

This, in other words, means that the prior art did not have the 'substation" and therefore, in order for Mastini's patent to be granted, it should have had the substantion.

Now, if the prior art did not have the "substation", then, it didn't even have the disconnection of this (one cannot disconnect something that isnt' there).

If the disconnection was missing in the prior art, Mastini, could not have been forced to include or exclude any disconnection whatever, and, thus, if Mastini was not forced, no estoppel exists.

The foregoing has show the absolute inexistence of a File Wrapper estoppel and has proved, therefore, that the declared "estoppel" was due the fact that the Courts below had not well interpreted the original application and drawings, Fig. 1 and Fig. 2, making an evident error in fact. Also without expert opinion to guide them (which they were deprived of by the summary judgment). They had no opportunity to visualize the differences.

AGAIN ABOUT THE AUTOMATIC DISCONNECTION

The trial court in its summary judgment, page APP. II , Vol. 1, stated:

> "The early Mastini claims, while not containing a provision for disconnecting a substation from the central station..."

Instead, in the document page 88a Vol. II, the original claim 2 clearly speaks of a "taking off".

In common language, the"taking off" refers to a manual action upon the hand-set of telephone apparatus, but original specification (Record. Vol.II 85a, original claim 2, Vol.II 88a, and original Fig. 2 Vol.II, 91a,)proves that in the present case, the "taking off" is an automatic and not manual action. The "manual" action in the original application was indicated in original claim 1, and Fig. 1 (85a-88a. Vol. II) where no automatic means are described or outlined.

But, however said words can be intended, it is evident that the trial Court stating that the "early Mastini claims had no disconnection" has made a second plain error in fact. The Court of Appeals has made the same error.

Since, by this authority:

(C.C. Patent Appeal-1942) 127 F.2d 312:

> "Subject matter recited in a claim embraced in an application as originally filed, is itself a part of the disclosure even though it may not be defined in the specification."

the "taking off" was in the original application, then its automatic disconnection made

part of the disclosure and it proves that both the Courts have really made this error.

III

ALTHOUGH THE INVENTOR HAD NOT ACQUISCED TO THE CANCELLATION OF HIS ORIGINAL CLAIMS, THE LOWER COURTS HAVE DECIDED AS IF HE HAD ACQUISCED

The Court of Appeals below in its decision has written:

> "Further, the File Wrapper history illustrates that Mastini was forced to cancel his early claims because of various prior art reference. To overcome these references new claims were submitted"

But the cancellation alone of original claims does not create File Wrapper estoppel if the subsequent allowed claims have retained all the substance of the claims rejected, showing thus that the inventor had not acquisced.

The submission of new claim was made only to make a new wording and not to surrender some part of disclosure originally presented.

The proof that Mastini had never made any acquiscence exist in the File History.

In fact, on page 103a, Record, Vol.II, in respect to rejection of claims 1-7, he said:

> "Demarest refers to two central telephone stations A and B...Therefore Demarest's system is for central stations.... "

On page 124a, Vol.II, Mastini said:

> "Morris refers to repeating stations for long distance transmission..."

on page 103a, Vol.II Mastini had written:

> "The various references (Demarest and Morris) discloses nothing of this type."

Again on page 124a Vol. II, in respect to rejection claims 8-11, Mastini said:

> "...that none of the references discloses a local telephone substation ...in combination with means whereby a local radio receiver station upon reception of a radio signal cause the disconnection of the wire lines and their subsequent connection to said receiver..."

It is evident therefore that Mastini always had submitted remarks contradicting the Examiner's objection; Mastini never made an acquiscence or acceptance. It is also evident that the Examiner had always accepted as good and exhaustive, the Mastini remarks both in respect to the first rejection (Demarest and Morris) and to the second rejection (Williams).

The fundamental view of the Second Circuit about the File Wrapper estoppel was set dowwn in Westinghouse Electric Mfg. v. Condit Electric

194 F. 427 (CCA 2 Circ.) as follows:

> "original claims were rejected in Patent Office. Thereupon applicants instead of limiting their claims, substituted broader ones which were accepted. Presumably the Examiner changed his mind.."

In Westinghouse Co. v. Boyden Co. 170 U.S.537 18 S.Court 707; 42 L.Ed. 1136, it is written:

> "But when we consider that often the employees in Patent Office are inexperienced persons and that the mass of the business is so vast that it is impossible for the Commissioner or the Chief Examiner to review it.."

Then, it is conceivable that an examiner, after the technical clarifications obtained by the inventor could have changed his mind and allowed by a different wording, the same substance of claims heretofore rejected.

Also, the following authorities are pertinent:

> 106 Fed. 693 - National Hollow Brake-Bean v. Interchangeable Brake Co. page 714:
>
> "One who acquisces in the reject of his claims because it is said to be anticipate by other patent or reference is not thereby estopped from claiming and securing by an amendment claim ever know and useful improvement which he has invented that is not disclosed by those references."

Donaldson v. LaMaur Co.(8 Cir.1962) 299 F.2d. 412 cert.den.83 S.Ct.27; 371 U.S. 906 (L.Ed. 57).

"Plaintiff who had not acquisced to Patent Office repeated rejection of its claims but had by repeated amendments and finally prevailed, was not estopped from claim invention on claims."

Priebe & Son v. Hunt, CCA. Iowa-188 F. 2d. 880 cert. den.:

"Applicant for a patent did not surrender his broad claims in making an amendment of application and the Patent Office did not make the amendment a condition of the grant, there was not File Wrapper estoppel."

D.C. Ill. 1940 - 45 F.Supp. 927 - aff'd. 136 F.2d 159 cert.den. 64 S.Ct.593 - 321 U.S. 275 - 88 L.Ed. 721.

"In action for infringement,defense of File Wrapper estoppel was unavailing where it was concerned with elements old in art, not essential to the patent and not claimed as invention by plaintiff"

In the instant case, the elements old in art,not essentials and not claimed as invention, are the manual switch of the Fig. 1 and the automatic switch of the Fig. 2 of the patent.

Since the "principle" of the invention is that to "added" a fixed automatic radio complex to a "substation" without indication of a specified method to make said "addition", and since the functioning of the system is equally possible with one or with other types of switch (in fact the

defendants "mobile system"actuated by manual switch is functioning well as the automatic switch described in patent) it is evident that it is not essential the automatic switch. Both switches are interchangeable.

Thus, the Court of Appeals in disregarding the fact that Mastini had not acquisced to the cancellation of his original claims and in stating, substantially, that the cancellation had created an "estoppel", made a decision in conflict with applicable authorities.

IV

SINCE THE PRIOR ART WAS NOT PART OF THE RECORD, THE LOWER COURTS MADE A DECISION IN VIOLATION OF REPEATED APPLICABLE AUTHORITIES.

The trial court, in interpreting the Mastini claims during the summary judgment,without expert witnesses,stated (Rec.APP. 7 Vol.I)

> "However, there seem to be authorities that claims are to be interpreted in the light of description..."

> "We find that an examination of the File Wrapper in the present case reveals..." (Rec.APP.15 Vol.15).

Therefore, there was an examination of the description and of the File Wrapper only, but none of the prior art.

But the U.S. Supreme Court has stated that

in interpreting patent claims, it is necessary that there be the direct examination, by the trial court, of the prior art cited, in order to know which was the contribution of the invention to said prior art and which was the real "point" of the invention in order to know if and what should the inventor surrender on prior art of what he has improperly included in his original application, and all this especially when the trial court shall make a decision upon a defendants defense of file wrapper estoppel.

It is obvious that the Supreme Court in stating the necessity of an examination of the prior art in construing a patent, intended a direct examination by the Court of the original documents constituting the prior art (in the present case the patents Demarest, Morris and Williams) and certainly not to the generic summarized motivations of the examiners as read in File History.

In the present case, the lower court, although the prior art was not before it, stated (APP.9 Vol. I):

> "none of the seven claims in Mastini's application as originally filed were limited to the automatic disconnect features; all were rejected on prior art; he cancelled all seven and submitted new claims 8-11 likewise not limited; again all were rejected on prior art and were finally cancelled"

Apart from the error of having stated that "none of the seven original claims were limited to the automatic disconnection" when instead the original Fig. 2 and the claim 2 had the

disconnection, as demonstrated in previous Point II of this petition, there remains the fact that the trial court believed "equivalent" to the direct complete examination of the prior art as required by law, the ultra-summarized phrases of the examiner:page 92a-Record VolII.

Mr. Justice Clark in recent case Graham v. John Deere Co. 383 U.S. 1 (1966) on page 17 stated:

> "Under Sect.103 the scope and content of the prior art are to be determined; differences between the prior art to be acertained;..."

On page 33 he stated:

> "Claims as allowed must be read and interpreted with reference to rejected ones and the state of the prior art;.."

In the case of Mineral Separation v. Hyde 242 U.S. 261 - 37 S.Ct. 82 it was stated:

> "A patent is to be construed in the light of the state of art at the time it was granted"

(C.C.A. N.Y. 1942) Moto-over Co. v. E.C. Steam, 126 F.2d 854

> "The interpretation of the breadth of claims rest on prior art"

Schering Co. v. Gilbert 153 F.2d. 428 (C.C.A 2nd).

> "The questions of invention must be resol-

ved in the light of what the situation was when the inventors makes their contribution to the art"

James Marsh v. U.S. Gauge Co. 129 F.2d 161 (CCA 7 Ct).

"Infringement turned on construction given claims after reading them and specification in light of the prior act."

These authorities were not respected by the lower courts. The principal reason for the failure to examine the prior art was that the three prior art cited in File History were not before the trial Court. This fact was made available to the Appellate Court (Record 662, pg. 2-3 of plaintiff's brief on appeal on Rule 60(b) motion, and also in oral argument (Exhibit [redacted] this Petition)).

Thus, lacking the examination of the prior art, summary judgment could not be granted.

In fact, in case of Vermont Structural Slate Co. v. Tatko Bros. Slate Co. (2 Cir.1956)233 F.2d 9, cited by the Court of Appeals itself in its decision, states:

"Action is appropriate for summary judgment where claims of patent and prior art are understandable without aid of expert witnesses."

But, since in the present case the prior art was totally missing no examination was made; therefore it was not possible for the lower Courts to know if the prior art to be examined was or was not understandable by them without expert wit-

nesses by judicial notice only.

The trial court had nothing before it of said prior art. But the Court of Appeals, although they did not have all the three prior art patents before it, had the Williams drawings and therefore should have had a sufficient clue of their complexity (Record Vol.I APP. 69-70 (b) included in Appendix instead of in the brief as an Exhibit).

However, the Court of Appeals should have noted that in the drawing APP. 69 (R.Vol.I) it was indicated by a circle, the lack of the substation 9 of the patent.

The court below could and should have considered that if in the prior art there was lacking the substation, then there was obviously lacking any kind of disconnection, including, manual.

Note that the lack of substation in the prior art's document APP.69 (R.Vol.I) was noticed to the Court of Appeals also during the hearing of the appeal (Ex. I to this Petition).

Therefore, according to the above-mentioned authority, missing the examination of the prior art, the summary judgment was not appropriate.

Moreover, the defendants themselves on page 6 of their brief on Rule 60(b) appeals had written:

> "Defendants-appellees' radiotelephone system also use electronic device, of course, but their specific arrangement is fundamentally different from that disclosed and claimed in the Mastini patent".

This Court of Appeals stated:

"...there is not genuine dispute as to facts".

It is submitted that the comparison of said arrangement of electronic devices with the correspondent's electronic arrangement disclosed in patent, should be considered by the Court of Appeals as a genuine issue of fact.

The significance of the prior art with respect to the scope of the invention, the individuation of the exact, scientific meaning of "radiosignal" and "demodulation" and of the following technical terms, were all genuine issues of fact to be examined in a regular trial with expert witnesses cross-examined:

Demodulation and detection
Trunk lines and "ordinary wire lines"
P.B.X. and P.A.X.
P.B.X. and ordinary telephone
Isowave and multiplex swtb
Single swtb and multiple swtb
Scheme Fig. 10 and scheme Fig. 10 prior art.
Operation of calling signal in patent cl.8
Claim 8 and calling signal in claims 9, 10 and 11.

all patent words noticed to the lower courts on page 11 of plaintiff's brief for appeal for rejection motion Rule 60 (b)

"Infringement is a question of fact"

Stilz v. U.S. 269 U.S. 144 - 70 L.Ed.202.

V.

DECIDING AGAINST THE PLAINTIFF BECAUSE HE HAD NOT INDICATED IN HIS PATENT ANOTHER MODE OF ACTU-ACTION OF HIS INVENTION, IS AN ER-ROR IN LAW IN VIOLATION OF CLEAR AUTHORITIES OF THIS SUPREME COURT

In its decision the Court of Appeals below stated:

> "The patent itself sets out in detail the functioning of an automatic system but does not mention the possibility of manual operations."

But the United States Supreme Court authorities have stated:

> "An inventor must describe what he conceives to be the best mode but he is not confined to that. If this were not so most patents would be of little worth."
>
> 210 U.S. 405- 28 S.Ct. 748 - Continental Paper Bag Co. v. Eastern Bag Co.

Moreover the Supreme Court in the case of Webster Loom Co. v. Higgin 105 U.S. 580 stated on page 586:

> "That which is common and well known is as if it were written out in the patent and delineated in drawing."

Also in the case of

210 U.S. 405- 28 S.Ct. 752 55 L.Ed. 527 the Supreme Court stated:

> "The claims of a patent measure the scope of a patent monopoly and may be explained

and illustrated by the description but the description does not necessarily limit the claims. "

In the case of Smith v. Snow 294 U.S.1, Mr. Justice Stove stated:

"The claim is not limited by the particular mode of use described in specification since the claims of the patent, not its specification, measure invention."

(5 Cir. 1958) Brian v. Richardson 254 F.2d 191- cert.den. 79 S.Ct. 22 358 U.S. 815:

"When the novelty of the combination is adequately disclosed with definable limitation, other well-known elements need not be described in structural detail in the specification of the patent."

(9 Cir.) Cutter Laboratires v. Lyophile Co. 179 F. 2d 80:

"In any event the narrowing claims by reference to the specification would be improper." Graven Tauk v. Linde Air Product, 336 U.S. 271-69 S.Ct. 533.

In any way, it is not correct that in the Mastini patent, the possibility of manual operations was not mentioned.

Instead, the "principle" of the invention speaks of "added" and not of "automatically added". In original Fig. 1 and Patent Fig.1 there is missing all references to "automatic" means and in the original claim 1 there also is completely missing references to automatic terms, thus showing the inventor's intention

for manual system.

Thus, if original Fig. 1 and claim 1 had intention to describe an automatic system, there would have been no need to create Fig. 2 and claim 2 both of which described an automatic system and would have been adequate if original claim 1 and Fig. 1 were the only system sought to be patented.

Another clear indication of the Mastini intention for manual operation is given by the patent in claim 8 where it is stated:

> "...means for transmitting a calling signal..."

Nothing in claim 8 is indicated to accomplish said transmitting operation by some automatic means. These automatic means are instead readable in subsequent claims 9-10-11 which states:

> "...for modulating the carrier wave of the local transmitter for sending to the remote radio receiver a calling signal.. said last means activated by a calling signal coming from the central station."

In claim 8 none of this system of activation is indicated. Claim 8 describes a semi-automatic system with a manual operation.

(CC.Patent Appeals 1960) Application of John Nelson 280 F.2d 172:

> "Description in patent are not addressed to public generally, to lawyers or to judges, but to those skilled in the art to which the invention pertains or with which it is most nearly connected."

(5 Cir.) 122 F.2d 650 -cert.den. 79 S.Ct. 22. - 358 U.S. 815
V.D. Haden Co. v. Mathies Alkal Work.

"Claims are to be read in the light of other claims"

In the case of Smith v. Snow, 294 U.S. 1, already cited, Mr. Justice Stove, stated at page 13:

> "The fact that a claim, broadly covering the essential of an invention, omits particular means of application which is called for by other claims is evidence that the broader claims was not intended to be so restricted."

Also, if were true that Mastini had not included in broad claim 1,2,3 the "means" for a manual operation, the cited authorities of the Supreme Court permits a finding in claims 1,2 3 in the light of claim 8, the inventor's intention also for a manual operation.

The Court of Appeals, having based its affirming decision upon the lack of a non-necessary condition, has rendered a decision in conflict with authorities of this Supreme Court and of other Circuit Courts,

VI

AUTHORITIES OF THIS SUPREME COURT STATE THAT NO REFERENCE TO THE PREVIOUS CORRESPONDENCE BETWEEN INVENTOR AND THE PATENT OFFICE CAN BE USED IN CONSTRUING A PATENT AND THIS SPECIALLY WHEN,AS IN THE PRESENT CASE,THE REFERENCE JUSTIFYING THE AFFIRMING DECISION,WHERE NOT PERTINENT

The Court of Appeals as a reason for its decision, quoted Mastini as saying "none of (these references) described the idea of automatically switching...". It interprets this statement to mean that none of the prior arts included an automatic system and therefore the claims should include an automatic system to be differentiated by the prior arts, as if the invention had a sole point of invention, that this point was in the means and only to the "automatic means". But independently from this that was already discussed on other points of the present petition, is that said quotations, appeared in remarks of the inventor in the File History, were attached and were only referred to the claims 16 to 21, dated November 4,1936.

To ascribe this statement to the previous claims 12,13,14 would be erroneous since no reference to any automatic system was made to them in Remarks for claims 12-14 and none was intended.

The statement cited by the Court of Appeals clearly applied only to "new claims submitted hereby" which, of necessity, were at least 3 months old.

Also the quotation: "Elsewhere Mastini distinguishes..." since also it was referred, not to claims 12-14, but to prior claims 8-11 cancelled (Record.Vol.III No. 293a).

In any way this authority is pertinent:

Piper v. Brown 91 U.S. 37

"A patent is to be construed without reference to previous correspondence with the Patent Office in relation thereto or rejected application for."

It is evident that there was a violation of this Supreme Court authority, by the Court of Appeals.

VII

THE COURT OF APPEALS ALSO ERRED WHEN IT INCORRECTLY OBSERVED THAT THE "ALTERATION" (ADDITION) WAS IN THE TELEPHONE CENTRAL PLANT. BUT IT WAS, INSTEAD, IN A SEPARATE, FAR TELEPHONE BRANCH, TECHNICALLY EQUAL TO ANY TELEPHONE BRANCH IN HOTELS, COMPANIES, PUBLIC OFFICE, ETC.

The Court of Appeals in its decision stated that "Mastini's invention requires alteration only at the subscriber's telephone, not at the central plant".

It is evident that the Court of Appeals has believed that the "Mobile Service Position" was installed inside the central plant. It is not so.

The Mobile Service Telephone, where arriving, via radio from the remote mobile station, telecommand of relay 41 (this calling telecommand is the first point of novelty of the Mastini invention), is outside the "true" central plant, namely outside the plants, the big rooms where are located thousands of switching mechanisms operated by dials from home or office through thousands of telephone lines. The "Mobile Position" is located in a special branch technically equal to any telephone branch, as in hotels, private companies, public offices, etc., where are used small switch-

board called "Private Branch Exchange (PBX) using a subscriber telephone line with dial incorporated in a single switchboard.

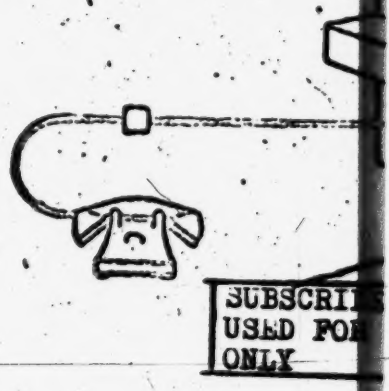
Also, the "Mobile Service Position" uses a switchboard from which start a "subscriber" telephone lines with dial. Also said switchboard is a "single" and not "multiple" switchboard, also if it serves 100 mobile subscribers, one at each time yet as in a party lines as foreseen, also by the Mastini patent (R.Vol.II page 87a line 25). Said switchboard is technically equal to any "single" P.B.X. but very different from a "multiple switchboard" used in the real central plant for "Long Distance Service."

The attached document "1955 Mobile Telephone System" is a defendants document showing at left the "true" central plant and, at right, the "Mobile Service Position."

Therefore there are two stations: the "Local Switchboard" (central plant) and the "Subscribers Branch Switchboard" for Mobile subscribers connected to the "central plant" by usual subscriber lines (visible in the same drawing) as any private telephone branch outside the central plant (Hotel, Companies, etc.).

Therefore the "alteration", namely the "addition" of the automatic radio complex to the telephone substation is made into a separated, distant building and not inside the true central plant.

The Court of Appeals has not well observed the attached defendants document existing in Record, 206a, Vol.III, making thus another plain error in fact.



Block diagram sho
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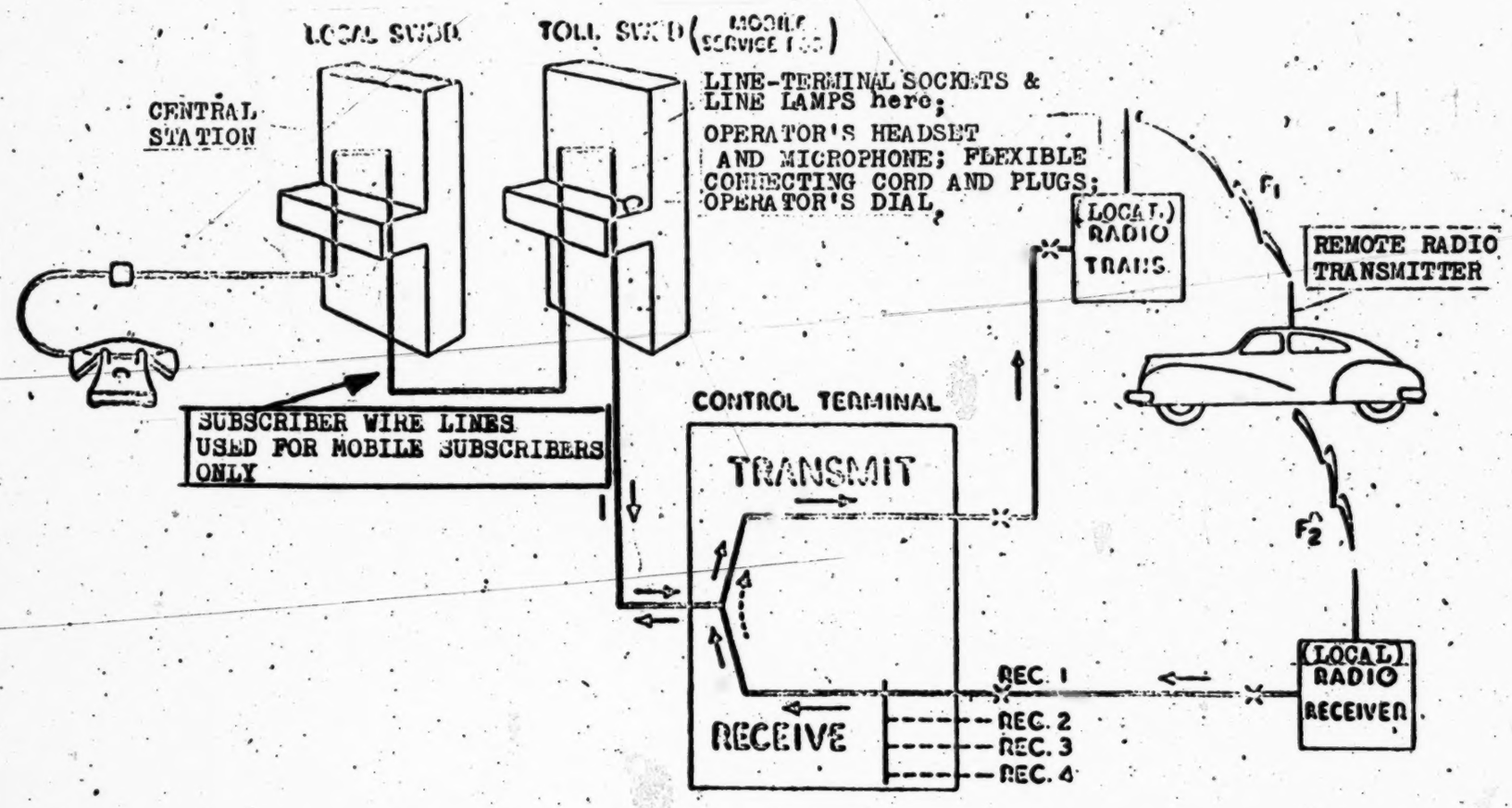
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fact.

1955 MOBILE TELEPHONE SYSTEM DOC. 14



Block diagram showing path of a call from a land telephone, through local switchboard mobile switchboard, control terminal, transmitter and car.

Moreover, the Court, stating that the patent described the substation as a "subscriber's station", has not observed that in the original claims 1 and 2 (Rec.Vol. II page 88a) were included the words:"subscriber stations" and "usual telephone apparatus" inside said "subscriber station and that the clause in patent claims "Local telephone substation" (APP.15 Rec.VolI) is correspondent to the clause "subscriber stations" in original claims, intended as a "place" containing a "telephone apparatus".

Now also the Mobile Service Position is a "place" where exists, not a generic non-subscriber telephone apparatus, but a "real" "subscriber telephone" serving only and exclusively mobile subscribers.

It is not material if said subscriber telephone use a "headset" apparatus,incorporated in a single switchboard, or uses a "hand-set" apparatus.

To note that the same trial Court on page APP. 5 (Record Vol.1) of its decision stated:

> "According to the literal meaning of this claim, the elements of defendants network can be read to be within plaintiff patent.
>
> There is no indication that a local telephone substation cannot be a telephone switchboard with an operator."

It is also not material, in a patent case, that the patented device be located in a private premises or in a telephone premises. Questions of title of real estate are not technical questions to be examined in a patent case.

The foregoing has thus proven that the Court of Appeals has made also upon said points, plain errors in fact and in law.

VIII

SINCE BETWEEN THE DECISIONS OF THE LOWER COURTS THERE IS AN EVIDENT NON-CONCURRENT FINDING UPON A BASIC FACT OF THE CASE, CERTIORARI SHOULD BE GRANTED.

The Court of Appeals stated:

"Again, as Mastini was forced to add this substation to his claims to avoid rejection on prior art...."

The trial court had decided that Mastini was "forced" only to an automatic method for disconnect the substation.

It is evident therefore that the Court of Appeals decision it is not "in concurrence" with the trial court decision upon the fact if Mastini was forced or not to the inclusion in its claims, of the substation.

The trial court has never denied the existence in original claims of the substation. It had only limited the broad meaning of the patent clause "local telephone substation" (APP.5 Rec. Vol. I).

It is undeniable that said non-concurrence exists proving that the Court of Appeals decision is erroneous upon an important point: If Mastini was not forced to the inclusion of the substation (and clearly Mastini was not) then he is not estopped to the application, in his favor of the theory of equivalents.

In such a case, to him the Court of Appeals should recognize to Mastini the right to protects also the use, in his patent, of a "headset" telephone, obviously equivalent to a handset telephone, be, this, incorporated or not in a switchboard in a private premises or in a telephone premises.

Said question of the equivalence of the two telephone apparatus was raised by the plaintiff in Record 269-16 of the plaintiff Memorandum in opposition to defendants motion for summary judgment included here as Exhibit N.II.

About the non-concurrence of findings between decision of the two lower Courts, this Supreme Court stated:

"Finding of fact concurred in by the two lower courts will not be disturbed unless clearly erroneous"

Washington Securities Co. v. U.S.
234 U.S. 76

"Moreover, the decision on that point rest on concurrent findings. They are not to be disturbed unless plainly without support."

272 U.S. 1- 47 S.Ct. 1 - 71 L.Ed. 131
United States v. Chemical Foundation.

Moreover the Court below has not considered this other authority:

"Federal Court of Appeals may not try civil case de novo and they may not

make new finding of fact"
Hycou Mfg.Co. v. Koch
219 F.2d 353

on the same case the Court stated:

"A finding upon summary judgment will be set aside if there is dispute as to fact"

To have stated that Mastini was forced to the inclusion of the substation was a "new" fact-finding, also it was not permitted in a case of summary judgment.

Since it is undeniable that Mastini was not forced to include the "substation" it is believed that this Supreme Court will grant the certiorari requested:

IX

SINCE THE SAME PATENT IS INVOLVED IN SEVERAL SUITS IN DIFFERENT CIRCUITS, IT IS BELIEVED THAT THIS COURT IN ACCORDANCE WITH ITS AUTHORITIES WILL GRANT THE REQUESTED CERTIORARI

Several suits, based upon the same patent here considered were already filed and again entertained in District Courts of other Circuits.

They are in number of five (excluding those of the defendants in this suit) in District Courts of New York, Delaware and Maryland.

In District Court of Delaware (Case N.3119,Exhibit IV to this Petition) and in Maryland they were brought under Rule 60 (b) in order to obtain a setting aside of the same trial court's decision now before this Supreme Court.

Since also if said certiorari were denied, its res judicata would not be operative in suits with different defendants then the above mentioned five suits will again continue. It is very probable that the plaintiff with witnesses not found during the summary judgment, can obtain a decision in his favor as justice requires.

This Supreme Court in case of Schriber & Schroth v. Cleveland Trust Co., 314 U.S. 594, stated:

> "While there was not conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in Second Circuit that litigation in other Circuits resulting in conflict of decisions is unlikely"

It is opportune point out that other suits could be again brought in other Circuits because the Mastini patent, during its life, was manufactured also by several other manufacturers and because,with respect the Mastini patent vested in Alien Property Custodian for about 14 years, the statute of limitation of the Section 286 of Title 35 is not operative, having the U.S.Government returned to the inventor its patent by a Return Order

N:2578 included here as Exhibit III.. This Return Order, when read in the authority written on page 5 of this Petition, permits the recovery of the damages for "the past infringement thereof" obviously without limitation about said"past."

X

THE COURT OF APPEALS BELOW MAKING ITS DECISION UPON A SUMMARY JUDGMENT DEPRIVED OF FINALITY HAS VIOLATED TITLE 28,SECT. 1291 RENDERING THUS A DECISION VOID ON JURISDICTIONAL GROUND.

The petitioner by motion (Record Vol.II page 234) and better in additional arguments (Record Vol.II page 248a) and orally during the hearing of said motion, asked for a stay of the proceeding of the appeals N.29628 against the summary judgment (Rec.APP.1 Vol. 1) because two separated and independent actions had been filed under Rule 60 (b) F.R. C.P. in Delaware and Maryland District Courts (Record Vol.III # 298 and Exhibit IV here) for the setting aside of the summary judgment of the trial Court below.

These independent actions were brought especially in order to point out to the Courts, in a regular trial, the testimony of the two Examiners that in the far 1935-1938 had examined and granted the Mastini patent in issue.

Because the long time elapsed it had been impossible for the plaintiff to find them before the rendering of the summary judgment.

The plaintiff, under the circumstances of a summary judgment upon an electronic patent where several technical terms had been misinterpreted by judicial notice not aided by expert testimony, believed and still believes that he has not had due process.

By said independent actions the plaintiff raised two advantages:

1. The Rule 60 (b) specially provides that only when a motion (as distinguished from an "independent action") is filed under the Rule, the "finality" of the judgment is not affected nor its operation suspended.

Thus when an independent action is started and maintained (as in the present case also with discovery) under that Rule, the judgment cannot be considered "final" and the proceeding for appeal must be suspended.

2. In the case Hazel-Atlant Glas v. Hartford Co. 64 S.Ct. page 1005 reads that an independent action acts as a Court of first instance.

In the case of Consolidated Gas and Equipment Co. of America v. Carver 257 F.2d 111 (10 Cir) reads:

"An independent action requires a full hearing of the merits of the claim; the instant motion reserve to the Court the propriety of conducting such hearing."

Thus the plaintiff could finally have at least in one Court a full hearing of his case.

Thus the two Examiners could make clear to the Court the significance of the prior art and the scope of the Mastini patent by the exact scientific interpretation of the electronic or electrotelephone terms included in patent claims.

But the above mentioned motion for a stay of the proceeding was denied by abuse of discretion with an order not final and therefore not appealable.

On November 16, 1966, the appellate case N.29628 with other consolidated cases was argued by an occasional lawyer (because the plaintiff pro se was in bed with pneumonia (page 299a Vol.III) not sufficiently prepared (page 300a Vol.III).

Then the Court disregarding that in the record before it there was notice of the actions depriving of finality the summary judgment, has equally rendered its decision in violation of Title 28 Sect. 1291. Yet making a decision void on jurisdictional grounds.

The Court of Appeals should not have rejected the motion for the stay. But if said rejection was discretional, it was not discretional the examination of the record in order to take further notice of the lack of its jurisdiction.

The following authorities are pertinent:

(C.A.N.Y. 1966) Ira Haupt v. Knapp - 361 F.2d 164

"Court of Appeals is bound to consider

and determine its jurisdiction even though not questioned by the parties"

(C.A.Tex). Anastasiadis v.S.S.Little John 339 F.2d 538:

"Court of Appeals must notice jurisdiction defects sua sponte"

The hearing of the appellate case should be suspended until the jurisdictional question was resolved.

In the case of Page v. Wright 116 F.2d 452, reads:

"In that case it was argued, as here, that the defendant has waived or was estopped from raising the jurisdictional question after the case had been decided upon the merits.

The Court (the Supreme Court) decided against this contention and on page 326 of 129 U.S., page 292 of 9 S.Ct., 32 L.Ed. 690, said:

'We have already seen that this Court must, upon its own motion, guard against any invasion of the jurisdiction of the Circuit Court of the United States as defined by law, where want of jurisdiction appears from the record here on appeal or writ of error.'"

In the case of Mansfield Co. v Swan, 111 U.S. 379, 4 S.Ct., 510, 29 L.Ed.462, this Supreme Court stated:

"It is duty of the Supreme Court of its own motion, to note critically

the record upon which a case comes before it, in order to test the jurisction of the Court below."

The Court of Appeals denying the stay has not permitted to plaintiff to continue in Delaware and Maryland Courts the proceedings of the independent actions.

Both said Courts upon unfair defendants motion have stayed said actions.

Thus instead (Exhibit IV here) of staying the appeals for summary judgment there was stayed the actions that had originated the lacking of finality.

Consequently, the plaintiff not even in said two Courts could have a regular trial with expert testimony. Thus the plaintiff had been deprived of the due process by said substantial, if not formal, violation of the Fifth Amendment of the Constitution.

The foregoing has shown the lack of finality of the summary judgment prematurally argued and decided, and therefore the nullity of the Court of Appeals' decision.

CONCLUSION

The petitioner prays this Supreme Court to grant the requested certiorari.

Domenico Mastrui

LIST OF EXHIBITS

Exhibit 1.

Copies of pages 1 and 9 of the minute of the hearing on November 16,1966 (Argument 4 - page 32 petition)

Exhibit 2.

Copy of page 46 (Record 269-19) of the plaintiff memorandum in opposition to defendants' motion for summary judgment. (Argument VIII-page 44 petition)

EXHIBIT 3

Copy Return Order N.2578 of the Mastini patent (Argument IX-page 47 petition)

EXHIBIT 4.

Copy of order of the District Court of Delaware stayed the case N.1139 brought under Rule 60 (b) F.R.C.P. (Argument X -page 51.)

UNITED STATES COURT OF APPEALS

EXHIBIT 1.

FOR THE SECOND CIRCUIT

DOMENICO MASTINI,
Plaintiff-Appellant,
vs.
AMERICAN TELEPHONE & TELEGRAPH COMPANY and WESTERN ELECTRIC COMPANY,
Defendant-Appellees.

Miscellaneous No. 30806

DOMENICO MASTINI,
Plaintiff-Appellant,
vs.
NEW YORK TELEPHONE COMPANY,
Defendant-Appellee.

Before: HON. HAROLD R. MEDINA, Presiding,
HON. IRVING KAUMAN,
HON. WILFRED FEINBERG,
Circuit Judges.

New York, November 16, 1966;
10.30 o'clock a. m.

APPEARANCES:

HYMAN HURVITZ, ESQ.,
Attorney for Plaintiff-Appellant.

HENRY R. ASHTON, ESQ.,
Attorney for Defendant-Appellees.

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the diagrams, and they will illustrate the means.

MR. HURVITZ: If you would like me to, your Honor, I would be glad to.

JUDGE KAUFMAN: I don't know whether it is necessary. It is a question of infringement and do you think it is necessary in your argument?

MR. HURVITZ: I don't think it is necessary to do that because the issue here revolves around the file wrapper history as used to interpret the claims or the parts of the claim that the defendant has underlined in red ink.

JUDGE MEDINA: All right.

MR. HURVITZ: That is the real problem, as I see it.

JUDGE MEDINA: Of course, all the judge decided was on the issue of infringement.

MR. HURVITZ: That is all he decided and he decided that without consideration of the prior art to help him decide what the real scope of the invention was and he decided that purely by going into the file history and interpreting it to say that what Mastini invented was an automatic system for doing what he did and not one that could be operated by hand.

illustrated on the diagram of the Stipulation is maintained and operated by Defendants on their own property, with the exception of the car and the telephone at the extreme left of the diagram. While this may or may not be true, it does not change the fact that the claims and patent specification contain no limitation whatsoever as to whose property the various pieces of equipment will be located on. As a matter of fact, it is common knowledge that the ordinary telephone sets used by subscribers are owned by the Telephone Company and are therefore removed whenever service is discontinued. Thus, the telephone apparatus used by the operator, as well as the telephone apparatus used by a subscriber, are both owned by the Telephone Company. They both perform in the same way to accomplish the same result.

Hence, it is clear and reasonable that the term "sub-station" in the claims finds its full equivalent in the three-piece telephone set of the operator, which includes her earpiece-mouthpiece, the dial, and the signal lamp on the switchboard.

IV. DEFENDANTS' ARGUMENTS AS TO ESTOPPEL ARE FALLACIOUS AND IMMATERIAL

The file history of the Mastini patent has been carefully reviewed and studied as attested to in the affidavits

DEPARTMENT OF JUSTICE

OFFICE OF ALIEN PROPERTY

WASHINGTON, D. C.

EXHIBIT 2.

ASSIGNMENT

WHEREAS, the undersigned, acting for the Attorney General of the United States, by Return Order No. [illegible], directed that the vested property described below, now held by the Attorney General of the United States, as successor to the Alien Property Custodian, be returned to Domenico Mastini, Milan, Italy.

NOW, THEREFORE, pursuant to said Return Order, and pursuant to section 32 of the Trading with the Enemy Act, as amended (60 Stat. 50), there is hereby returned to Domenico Mastini the following property:

All right, title and interest in and to United States Letters Patent Nos. 2,129,332 and 2,152,903 vested by Vesting Order No. 201 (recorded in the United States Patent Office in Liber R-193, page 1), including all accrued royalties and all damages recoverable at law or in equity for the past infringement thereof.

This Assignment shall not be deemed to include the rights of any licensees under the above patents.

Executed at Washington, D. C., on

I hereby certify that the within is a true and correct copy of the original paper on file in this office.
For the Attorney General:
Dallas S. Townsend, Assistant Attorney General
Director, Office of Alien Property
By [illegible]
Assistant to the Records Officer

For the Attorney General:

(Signed) Paul V. Myron

Paul V. Myron
Deputy Director
Office of Alien Property

DISTRICT OF COLUMBIA } ss

I, [illegible], a notary public in and for the District of Columbia, in the United States of America, do hereby certify that on the date hereof, [illegible], Office of Alien Property, Department of Justice, personally known to me to be the same person who executed the foregoing instrument on behalf of the Attorney General of the United States of America, personally appeared before me and I having first made known to him the contents thereof, acknowledged that, pursuant to authority delegated to him by the said Attorney General by the Rules of the Department of Justice (16 F.R. 6895, July 18, 1951), and of the Notice of the Department of Justice, Office of Alien Property, Statement of Organization and Delegation of Final Authority (18 F.R. 7895, December 8, 1953), and as such officer he executed the foregoing instrument as the free and voluntary act of the said Attorney General and for the uses and purposes therein set forth.

WITNESS my hand and seal this 9th day of December, 195[illegible]

[illegible]
Notary Public

My Commission Expires:

6-30-57

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

EXHIBIT 4

DOMENICO MASTINI,

Plaintiff,

v.

AMERICAN TELEPHONE AND TELEGRAPH COMPANY, and THE DIAMOND STATE TELEPHONE COMPANY,

Defendants.

Civil Action No. 3066

DOMENICO MASTINI,

Plaintiff,

v.

AMERICAN TELEPHONE AND TELEGRAPH COMPANY,

Defendant.

Civil Action No. 3119

DOMENICO MASTINI,

Plaintiff,

v.

THE DIAMOND STATE TELEPHONE COMPANY,

Defendant.

Civil Action No. 3077

O R D E R

NOW, to-wit, this ninth day of June, 1966, this cause coming on to be heard on motion of defendants for an order staying proceedings in this action pending determination of the actions entitled, Domenico Mastini v. American Telephone and Telegraph Company and Western Electric Company, and Domenico Mastini v. New York Telephone Company, pending in the

Court of Appeals for the Second Circuit, and it appearing to the court that it involves the same subject matter and is between the same parties or their privies, and that it was commenced prior to this action; it is

ORDERED, that this action be and hereby is stayed, and that plaintiff be and hereby is stayed from taking any further action in this cause until final determination of the above pending New York actions, or until further order of this court.

CHARLES M. WRIGHT

C. J.